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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,057	09/25/2000	Bruce Brumberg	BRUM-101	2821

7590

09/29/2004

Robert K Tendler
65 Atlantic Avenue
Boston, MA 02110

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,057

Applicant(s)

BRUMBERG, BRUCE

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This communication is in response to amendment filed 6/28/04 and accompanying Rule 1.131 declaration.

Response to Amendment

2. Rejection of claims 1-16 over prior art references Cristofich have been withdrawn.

3. Claim 1 has been amended.

Analysis of Rule 1.131 Declaration

4. The examiner has carefully reviewed the newly submitted affidavit mailed 6/28/04 and determined that the evidence submitted is ineffective to overcome the Schultz reference. (see analysis provided below.) While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

To begin with, the Declaration fails to properly label various documents as Appendices identified in the Declaration. The examiner has used the description of each appendix provided in the Declaration to guide through the attached documents to correlate the appendices described in the Declaration. It is

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requested that all attachments be properly labeled. However, it is noted that this defect by itself does not render the Declaration defective. The examiner has applied the applied the following standard to determine the adequacy of the demonstrative evidence provided by the applicants.

"[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). and

(It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice."); *Hitzeman v. Rutter*, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001).

The applicant has not demonstrated how the documentary evidence supporting the declaration (Appendix A, a memo to Jesse

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Brill, from Bruce Brumberg, Re:MyStockPlan.com/MyStockOptionPlan.com and MyPOTofGold.com/MyGoldPot.com) meets limitations of the invention recited in claims 1-16. To overcome the prior art as a reference the applicant must demonstrate that a finite and permanent idea of the complete and operative invention was in his possession prior to the effective date of the Schultz reference. Since, the applicant has failed to provide any explanation demonstrating that the document cited as Appendix A meets this requirement (i.e. shows that the document meets all features of the claims 1-16 being sworn behind) the declaration fails to establish the conception of the claimed invention under the applied standard.

Based on this analysis the declaration filed, is insufficient to establish a conception of the invention prior to the effective date of the Schultz reference which is 1/14/2000:

Accordingly, claims 1-16 are rejected under 35 USC 102(e) as explained the following paragraphs.

Claim Rejections - 35 USC § 102

4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Schultz (US Pub. No. 2001/0056391 A1) (hereafter Schultz) and alternatively Claims 1 and 3-16 are rejected under

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35 U.S.C. 102(e) by Cristofich et al. (US Pat. 6,269, 346)
(hereafter Cristofich).

Per claim 1 Schultz discloses a method for providing an individual with education and training about an employee stock option ..comprising the steps of:

Storing relevant information about the stock option plan in edible form in a central server (see para [0034], host web site) and [0035]);

Modeling a projected outcome customized to the individual needs, the modeling being related to gain ..based on the relevant information..; (para [0038] The forecasts for each of the entered option-exercising scenarios can be compared 130 against at least one forecast determined from at least one standard option-exercising scenario. As with the received 110 scenarios, in an embodiment of the present invention, a plurality of predetermined, standard option-exercising scenarios are calculated to provide a broader basis for comparison.);

connecting the central server to the Internet;

([0034] The flexibility of the present invention's architecture enables it to simultaneously support different service models. For example, in accordance with an embodiment of the present invention, one model is the classic Web host model, where the optionee or the optionee's advisor accesses the system at a host web site via the Internet and completes a single sign-on authentication protocol..)

providing the information about the stock option plan to the individual ..and the results of the modeling done at the central server;

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(refer to Fig. 2 Tracker 210 and Forecaster 230 modules and relevant discussion at para [0068] through [0089])

having the individual provide inputs to the central server specifying user generated parameters relative to the stock option plan such that the user-provided information is used in the modeling..

(step 110 shown in Fig. 1 and discussed at para [0038]).

Per claim 2, Schultz discloses ..generating content at the central server which will aid the individual in the management of the stock option plan and ..educating, communicating..and transmitting the content over the Internet to the individual.

(Background and Figure 2, strategy module 250 which receives user selected stock and exercise information..refer to para [0079] for details)

Regarding claims 3-16 it is asserted that various features claimed therein are essential to calculation of optimization of the stock option plan or calculation of optimal strategy for a selected option exercising scenario selected by the participating individual and therefore anticipated by the prior art applied. Features recited in these claims are discussed throughout the Schultz references.

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Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

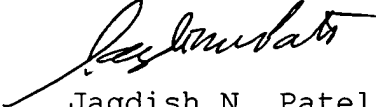
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

9/26/04